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BIOTECHNOLOGY LAW GROUP  
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In re Application of :  
Ed Nolan et al :  
Serial No.: 09/342,024 : PETITION DECISION  
Filed: June 28, 1999 :  
Attorney Docket No.: GENE1120-1 :

This is in response to the petition under 37 CFR 1.181, filed June 15, 2004, for withdrawal of abandonment of the above identified application based on filing of a timely reply.

A review of the file history shows that the examiner mailed a Final Office action to applicant on April 1, 2003, setting a three month shortened statutory period for reply. Applicants replied on September 29, 2003, by filing a Continued Prosecution Application (CPA) request and the fees therefore. Due to a change in the Rules of Practice in June, 2003, CPA requests could no longer be filed in utility applications. However, in accordance with Office policy the CPA request was treated as a Request for Continued Examination (RCE). Under 37 CFR 1.114 an RCE request must be accompanied by an amendment and response to the outstanding Office action. Applicants' CPA submission lacked the required response. A Notice of Improper RCE was mailed to applicants on October 23, 2003. Applicants state that the Notice was never received. It is noted that the Notice stated that the time period for completing the RCE request continued to run from the date of mailing of the Final Office action. Inasmuch as applicants filed the improper RCE at the end of the six month statutory period for reply, the Notice was mailed outside of that time period allowing applicants no time for correction of the RCE request. Thus applicants' non-receipt of the Notice did not affect the holding of abandonment in this application. Applicants and their representatives are also expected to be aware of changes in the Rules of Practice with respect to continuation of prosecution of an application.

A Notice of Abandonment was mailed to applicants on February 17, 2004. Petitions for revival of an application are expected to be promptly filed as set forth in 37 CFR 1.181(e) which allows a two month time period for filing of a petition from the date applicants are notified of the abandoned status of their application. Applicants' petition was not filed within the required two month period, but is accompanied by a terminal disclaimer and fee therefore. The terminal disclaimer has not been entered, but may be entered at a later date. Should the application be revived. Applicants have yet to file a response to the outstanding Final Office action.


The petition is **DENIED**.

Applicants have requested that the petition be considered alternatively under 37 CFR 1.137(a) and have paid the petition fee of \$110.00 for such petition. 37 CFR 1.137(a) provides for revival of an abandoned application under circumstances when failure to properly reply to an Office action is prevented by circumstances outside of applicants control (i.e.- natural disasters are the most common types of circumstances). Applicants' failure to properly respond to the Final Office action was not caused by circumstances outside of applicants' control, but by applicants' failure to follow the Rules of Practice.

The alternative petition under 37 CFR 1.137(a) is **DISMISSED**. Applicants may file a petition under 37 CFR 1.137(b) with required petition fee requesting revival of this application. The petition fee under 37 CFR 1.137(a) may be applied towards such petition fee. Any such petition must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely. The currently filed terminal disclaimer will be considered with that petition.

Applicants also need to clarify the status of this application as to whether it is to be revived only for the purpose of providing continuity between this and the continuing application on file or if this application's prosecution is to be continued in addition to the continuing application.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 703-272-0519 or by facsimile sent to the general Office facsimile number.

  
Jasmine C. Chambers  
Director, Technology Center 1600